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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,215	12/18/2000	Eugene H. Carlson	55313USA6A.002	4346

32692 7590 07/07/2003

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

13

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/740,215

Applicant(s)
Carlson et al.

Examiner
Nasser Ahmad

Art Unit
1772



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 16, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-47, 53, 54, and 63-103 is/are pending in the application.
- 4a) Of the above, claim(s) 31-47, 53, 54, and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63, 64, 66-88, and 91-103 is/are rejected.
- 7) ☒ Claim(s) 89 and 90 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2003 has been entered.

2. Applicant's arguments with respect to claims 1-30, 48-52 and 55-62 have been considered but are moot in view of the new ground(s) of rejection.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 66-70, 74, 76-82, 92-103 are rejected under 35 U.S.C. 102(b) as being anticipated by Bacon (5,632,946).

Bacon relates to a retro reflective article comprising an elongate carrier and a plurality of discrete segments of retro reflective sheeting disposed on the carrier. The segments are separate from an adjacent segment by a gap (col. 3, lines 45-46) and have a first major viewing surface contacting the second major surface of the carrier (col. 7, lines 55-58) with an adhesive. The segments form pattern, sign, letter, etc. The carrier is extensible (col. 3, lines 1-4) and the substrate is shaped as a curve. The sheeting is prismatic or encapsulated retroreflective sheeting. The substrate adhered to by the sheeting can be flexible such as garments (col. 1, lines 12-19). The segments

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are shown as identical in the drawings. The spacing of the discrete segments would inherently wrinkling when bent around a selected radius.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 63-64, 66-72, 74-88 and 91-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon in view of Vesely (3,936,467).

Bacon, as discussed above, fails to teach that the adhesive is provided with a release surface. Vesely relates to a retro reflective adhesive article provided with a release liner to protect the adhesive surface. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Vesely's teaching of providing protective release surface for the adhesive in the invention of Bacon wherein the adhesive is provided on the non-viewing surface with the motivation to protect the adhesive.

The adhesive strength of the different adhesive would have been obvious to vary depending on the desired utility such as for transfer application, the adhesive on the non-viewing surface would have higher strength.

It would have been obvious matter of design choice to modify Bacon by providing 25-75 mm long segments with gaps of at most 40% of length based on optimization of the segments on the carrier. Similarly, the formulae recited in claims 63 and ? would provide for optimum length and gap.

The gaps can be interpreted as non-reflective segments.

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8. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon in view of Schultz (4,085,314).

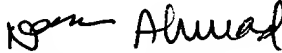
Bacon, as discussed above, fails to teach that the carrier has plurality of discontinuities. Schultz relates to retro reflective sheeting cut lines to form removable sections (abstract). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Schultz's teaching of using carrier layer containing slits in the invention of Bacon with the motivation to provide for removability and enhanced flexibility.

9. With regard to applicants' arguments in amendment filed on June 16, 2003, applicant should note that the phrase "the segments, not just the optics, are separated by a gap" could not be located in the claimed construction

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 703-308-4424. The examiner can normally be reached on Monday-Thursday from 7:30 am to 5 pm. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


NASSER AHMAD
PRIMARY EXAMINER

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N. Ahmad/mn

July 3, 2003